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Mr. Brady Dow
5154 Vancott Peak
Riverton, UT 84065

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/091,661	DOW, BRADY	
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing because it is not clear whether the Claim directed to the *system (network) or computer-readable medium* having instructions executable by the computer, which when executed by the computer, causing the following method steps to be performed: requesting the first component from the first central control; receiving a selection for the first component from the user; accessing an output associated with the first component; and presenting the output to the recipient via the telephone interface.

Claim 6 recites the limitation "the second component" in line 3 on page 31.

There is insufficient antecedent basis for this limitation in the claim.

The remaining Claims are rejected as being dependent on Claim 1.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing

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for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject

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matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Contrary to the claims in the above-cited cases, in the present application, the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The claims are completely devoid of any means to carry out a process implementing the step of: *using the conversation control system to access a central control, wherein a component is obtained from the central control; selecting the component for use on the conversation control system; initiating contact with a recipient; and presenting at least a portion of the component to the recipient.*

Section 100 (b) of Title 35 U. S. C. defines "process" to mean "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." "When Congress approved the addition of the term "process" to the categories of patentable subject matter in 1952, it incorporated the definition of "process" that had evolved in the courts" (footnotes omitted), See *In re Schrader*, 22 F. 3d 290, 295, 30 USPQ2d 1455, 1459 (Fed. Cir. 1994), which included this definition from *Cochrane v. Deener*, 94 U. S. 780, 788 (1877): "A process is ... an act, or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing."

Claims in the present application do not transform any physical subject matter or tangible (matter) into a different state of thing, and can be performed manually by a human.

The examiner recognizes that a statutory "process" under § 101 does not have to be performed by a machine, there must be a transformation of physical subject matter from one state to another, e.g., a step of "mixing" two chemicals transforms two separate chemicals into a manufacture or a composition of matter, regardless of whether it is performed by a human or a machine.

Claims in the present application do not recite transformation of physical subject matter.

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The examiner further recognizes that "subject matter" transformed does not need to be a physical (tangible) object or article or substance. Under the *State Street* test transformation of electrical signals into a different state or signal within a computer could constitute a machine implementation if the result has some practical utility.

However, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data. The method step of: *using the conversation control system to access a central control* could be understood as merely making a phone call to a recipient. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although *Bowman* is not precedential, it has been cited for its analysis.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) a network system, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

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As to "wherein" clause, it merely states the intended use of the invention, or the result of the limitations in the claim, and adds nothing to the patentability of the claim. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Noble, Jr. (US 6,356,634).

Noble, Jr. (Noble) teaches a method for interactive playback of selected scripted messages during a call engagement, comprising:

Claim 10.

Using the conversation control system (Fig. 1; computer 12) to access a central control (Fig. 1; server 16), wherein a component (script) is obtained from the central control (server 16) (C. 4, L. 41-44);

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selecting the component (script) for use on the conversation control system (computer 12) (C. 5, L. 9-12);
initiating contact with a recipient (C. 5, L. 12-13); and
presenting at least a portion of the component (script) to the recipient (C. 5, L. 13-15).

Claim 11. Said method, wherein the component is a script (C. 5, L. 51-53).

Claim 12. Said method, wherein the script comprises one or more script items (cells) (C. 5, L. 53).

Claim 13. Said method, wherein the script items are associated with one or more presentations (campaign) (C. 5, L. 53-55).

Claim 14. Selecting the script (C. 5, L. 9-12), and selecting one of the one or more presentations (campaign) (C. 4, L. 44-46).

Claim 16. Said method, further comprising:

receiving information from the recipient (C. 6, L. 35-36);

providing the information to a user (C. 6, L. 38-39); and

receiving a selection from the user indicating the portion of the component, wherein the portion of the component is selected at least in part in response to the information from the recipient (C. 6, L. 39-41).

Claim 17.

Providing a conversation control system, and

using the conversation control system (Fig. 1; computer 12) to access a central control (Fig. 1; server 16), wherein a component (script) is obtained from the central control (server 16) (C. 4, L. 41-44);

receiving information from a recipient and providing the information to a user (C. 6, L. 35-39);

based at least in part on the information provided to the user, receiving a selection of at least a portion of the component from the user, and presenting the portion of the component to the recipient (C. 6, L. 39-41).

Claim 18. Said method, wherein the component is a script (C. 5, L. 51-53).

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Claim 19. Said method, wherein the script comprises one or more script items (cells) (C. 5, L. 53).

Claim 20. Said method, wherein the script items are associated with one or more presentations (campaign) (C. 5, L. 53-55).

Claim 21. Presenting a script item in a selected presentation to the recipient as an audio signal (C. 5, L. 18-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble, Jr. in view of Borman et al. (US 6,748,055).

Noble teaches a system for interactive playback of selected scripted messages during a call engagement, comprising:

a central control maintaining a plurality of components (scripts) (Fig. 1; server 16);

a conversation control system communicably coupled to the central control via a communication network (Fig. 1; computer 12);

wherein said conversation control system includes: a computer interface operable to receive input from a user (Fig. 1; computer 12), and a telephone interface (telephone contact program), wherein said telephone interface accepts input from the computer and provides an audio output accessible to the user (C. 4, L. 49-63);

and wherein said computer is configured to: request a component from the central control (C. 4, L. 41-44); receive a selection for the first component from the user

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(C. 5, L. 9-12); access an output associated with the first component and present the output to the recipient via the telephone interface (C. 6, L. 39-41).

Noble does not specifically teach that said central control (server 16) includes a plurality of central controls.

Borman et al. (Borman) teaches a system for presenting voice applications (scripts) to telephone calls, including a plurality of hosts (servers) located across different continents (C. 4, L. 53-55), each host maintaining a plurality of applications to be presented to callers (Fig. 1, item 10; C. 7, L. 44-45, 65; C. 8, L. 25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Noble to include that said central control (server 16) includes a plurality of central controls, as disclosed in Borman, because it would advantageously allow to employ said system in different countries with different languages, as specifically stated in Borman (C. 11, L. 31-33), thereby maximize revenues.

Claim 2. Said system as in Claim 1. Language as to “wherein the first central control is maintained by a first entity and the second central control is maintained by a second entity” indicates intended use of the system and does not recite a structural limitation. Therefore, said language is given no patentable weight. MPEP 2106 (II) (C) states: “*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*”

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

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Thus the structural limitations of Claim 2 are disclosed in Noble in view of Borman as described herein. Also, as described, the limitations of the Claim do not distinguish the claimed apparatus from the prior art.

Claim 3. Said system as in Claim 1. Language as to “wherein the instructions executable to request the first component from the first central control include instructions to facilitate acceptance of terms offered by the first entity” indicates intended use of the system and does not recite a structural limitation. Therefore, said language is given no patentable weight. MPEP 2106 (II) (C) states: “*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*”

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 3 are disclosed in Noble in view of Borman as described herein. Also, as described, the limitations of the Claim do not distinguish the claimed apparatus from the prior art.

Claim 4. Noble teaches said system, wherein the communication network is the Internet (C. 1, L. 36).

Claim 5. Noble teaches said system, wherein the central control is a web-server (C. 4, L. 42).

Claim 6. Said system as in Claim 1. Language as to “wherein the instructions are further executable to: request the second component from the second central control; receive a selection for the second component from the user; access an output associated with the second component; and present the output to the recipient via the telephone interface” indicates intended use of the system and does not recite a structural limitation. Therefore, said language is given no patentable weight. MPEP

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2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 6 are disclosed in Noble in view of Borman as described herein. Also, as described, the limitations of the Claim do not distinguish the claimed apparatus from the prior art.

Claim 7. Noble teaches said system, wherein the component is a script (C. 5, L. 51-53).

Claims 8 and 9. Said method, wherein the script items are associated with one or more presentations (campaign) (C. 5, L. 53-55).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noble, Jr. in view of Feibelman et al. (US 6,499,017).

Claim 15. Noble teaches said method, including contacting the recipient via an existing telephone contact system (C. 2, L. 21-22).

However, Noble does not specifically teach that said existing telephone contact system includes POTS.

Feibelman et al. (Feibelman) teaches a method for provisioning a selected script to a customer over a telephone, wherein a network utilized is POTS (C. 3, L. 47; Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Noble to include that said existing telephone contact

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system includes POTS, as disclosed in Feibelman, because it would advantageously allow to use said method with most widely spread telephone system, thereby potentially maximize revenue.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See Form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

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7/27/2005